

Bowser for Reuters: Federal Circuit Rejects PTAB's 'Ministerial' Requirement for Prior Art Priority

By Jonathan R. Bowser | October 22, 2026

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Haynes Boone Partner [Jonathan Bowser](#) authored an article for *Reuters* analyzing a recent Federal Circuit decision clarifying when a prior art reference may rely on an earlier provisional or parent application filing date.

Bowser explains how the ruling requires inter partes review petitioners to demonstrate written-description support in the earlier application, increasing the burden for those seeking to rely on earlier priority dates and creating new opportunities for patent owners to challenge the validity of prior art references.

Read an excerpt from the article below.

A backdating issue

The scenario recurs often. An inter partes review petitioner wants to use a patent or published application as prior art, but the reference's own filing date is too late.

The reference, however, claims priority to a provisional or parent application filed before the challenged patent's effective filing date. If the reference can reach back to that earlier date, it becomes prior art. If it cannot, the petitioner's invalidity ground collapses.

Patent claims are governed under the AIA if they have an effective filing date on or after March 16, 2013. Patent claims with an effective filing date before March 16, 2013, are governed under pre-AIA law. ...

The statute supplies the answer

*The Federal Circuit based its decision in *Dental Monitoring SAS v. Align Technology, Inc.*, 184 F.4th 1376 (Fed. Cir. 2026), on the text of the AIA. Section 102(d)(2) gives a reference the benefit of an earlier filing date only "if the patent or application for patent is entitled to claim a right of priority under [§] 119."*

Section 119(e)(1), in turn, extends entitlement to provisional priority only where the invention is "disclosed [in the provisional] in the manner provided by [§] 112(a)."

Section 102(d) therefore incorporates a substantive written description requirement, and nothing in its text carves out prior art determinations or supplies a "less demanding 'ministerial' standard." ...

Takeaways

Petitioners bear a new burden of proof for prior art reference patents challenging AIA patents. Any ground resting on a reference patent's provisional or parent filing date now requires an affirmative

showing that the earlier application provides § 112(a) written description support for at least one of the reference's published claims.

That is a claim-by-claim, four-corners analysis — not a citation to the benefit claim on the reference's face. Petitions should build that record up front, with expert support, because the petitioner has the burden of persuasion to establish that a reference patent qualifies as prior art.

Patent owners gain a powerful gatekeeping argument. Where the petition is silent on claim support, patent owners can attack the reference's prior art status directly, without engaging the merits of the obviousness theory. In closely spaced priority contests, that argument may be dispositive. ...

Read the full *Reuters* article [here](#).